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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,458	02/10/2004	John Scott Heuvel	049220-9006-00	1353
23409 7590 11/01/2007 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202			EXAMINER NGUYEN, CHI Q	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/775,458

Applicant(s)

HEUVEL ET AL.

Examiner

Chi Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is in response the applicant's amendment filed on 7/21/2007.

#### ***Status of Claims***

Claims 1-21 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 103***

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 1,999,783 to Riesbol.

Claims 1-4:

Riesbol discloses in Fig. 2, a pre-formed concrete section 10 comprising a deck (wherein 10 points to) including a first side, a second side opposite the first side, and a width extending between the first and second sides, a top surface, a bottom surface opposite the top surface, and a thickness extending between the top and bottom surfaces, and a first leg 11 and a second leg 11 projecting from the bottom surface, a distance in a direction substantially parallel to the deck.

Riesbol discloses the basic structures for the concrete section as stated but does not specifically disclose a distance from the center of the first leg to the center of the second leg being more than two, three, four, or more than four times greater than the distance from the first side to the center of the first leg. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made for desirable application. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 5:

Riesbol discloses the basic structures for the concrete section as stated but does not specifically disclose a distance between the center of the first leg and the center of the second leg is more than half the width of the deck. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made for pathway clearance purposes. Furthermore, applicant has not disclosed the criticality of this feature.

Claims 6-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 1,999,783 to Riesbol in view of US Pat. No. 3,168,771 to Nelson.

Claims 6-7, 17:

Riesbol discloses in Fig. 2, a pre-formed concrete section 10 comprising a deck (wherein 10 points to) including a first side, a second side opposite the first side, and a width extending between the first and second sides, a top surface, a bottom surface opposite the top surface, and a thickness extending between the top and bottom surfaces, a first leg 11 and a second leg 11 projecting from the bottom surface, the deck further comprising a first outer portion F (see previous attachment of Fig. 2) extending generally from the first leg toward the first side, a second outer portion S extending generally from the second leg toward the second side, and a central portion disposed between the first and second legs, the thickness of the deck being substantially constant as the central portion extends along at least a portion of the width of the deck. Riesbol does not teach expressly a thickness of a deck generally decreasing as the first outer portion and second portion extend inwardly from the first the first leg and second

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leg to the central portion, respectively. Nelson discloses in Figs. 3-4, a pre-formed concrete section having two outer portions on either side of a leg 40, a thickness of a deck 90 decreasing as the first and second portion extend inwardly from the leg toward the central portion. In view of Nelson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Riesbol's pre-formed concrete section with tapered end outer portions for providing a clearance for bridge pathway construction.

Claims 8-9:

Riesbol in view of Nelson disclose the basic structures for the pre-formed concrete section as stated and further including the thickness of the deck at the first side and second side are less than the thickness of the deck at the central portion since both of the outer side portions are tapered therefore the thickness are decreased constantly.

Claims 10-11:

Riesbol in view of Nelson disclose the basic structures for the pre-formed concrete section as stated but does not specifically disclose the width of the deck is about 17-19'. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. Furthermore, applicant has not disclosed the criticality of this feature.

Claims 12-15 and 18-20:

Riesbol in view of Nelson disclose the basic structures for the pre-formed concrete section as stated but do not disclose a distance from the center of the first leg

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to the center of the second leg being more than two, three, four, or more than four times greater than the distance from the first side to the center of the first leg. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 16:

Riesbol in view of Nelson disclose the basic structures for the pre-formed concrete section as stated but do not specifically disclose a distance between the center of the first leg and the center of the second leg is more than half the width of the deck. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Pub. No. 2003/0140590 to Lancelot et al.

Claim 21:

Lancelot discloses in Fig. 3, a plurality of pre-formed concrete members or sections 12, each section 12 being a unitary construction comprises a deck 14 including a first side, a second side opposite the first side, and a width extending between the first and second sides, a top surface, a bottom surface opposite the top surface, and a thickness extending between the top and bottom surfaces, and a first leg 18 and a second leg 18 projecting from the bottom surface, wherein two sections 12 are connected to one another with the deck of each section being substantially co-planar

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and the second side of the deck of a first section is being connected to the first side of the deck of a second section adjoining the first section, the distance, in a direction substantially parallel to the deck of each section.

Lancelot discloses the basic structures for the concrete section as stated but does not specifically disclose from the center of the first leg to the second leg of the first section is greater than the distance from the center of the second leg of the first section to the center of the first leg of the second section adjoining the first section. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. Furthermore, applicant has not disclosed the criticality of this feature.

### ***Response to Arguments***

Applicant's arguments filed 7/21/2007 have been fully considered but they are not persuasive.

Applicant argues Riesbol does not teach or suggest the subject matter of amended independent Claim 1. More specifically, Riesbol does not teach or suggest a pre-formed concrete section including a first leg and a second leg projecting from the bottom surface, a distance, in a direction substantially parallel to the deck, from the center of the first leg to the center of the second leg being more than two times greater than the distance from the first side to the center of the first leg.

Examiner is not persuaded by the applicant's argument that the prior art does not disclose specifically a distance from the center of the first leg to the center of the second leg being more than two (claim 1), three (claim 2), four (claim 3), or more than

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four times (claim 4) greater than the distance from the first side to the center of the first leg because as previously stated in the Office action, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have a specific distance from a center of a first leg to a center of a second leg such as two, three, four, or more than four times for desirable application, (e.g. wider clearance for wider pathway).

Applicant argues there is no suggestion or motivation to combine the references: Riesbol '783 in view of Nelson '771, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, Riesbol's disclosure disclosed the invention as claimed except that the ends are tapered or a thickness of a deck generally decreasing as the first outer portion and second portion extend inwardly from the first the first leg and second leg to the central portion. As set forth in the Office action, Nelson discloses in Figs. 3-4, a pre-formed concrete section having two outer portions on either side of a leg 40, a thickness of a deck 90 decreasing as the first and second portions extend inwardly from the leg toward



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the central portion. In view of Nelson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Riebol's pre-formed concrete section with tapered end portions as taught by Nelson for providing a clearance pathway construction. Furthermore, applicant has not disclosed the criticality of this feature.

In regarding applicant's argument claim 21, examiner apologizes for a typographical error occurred in lines 1 and 11, respectively --Lancelot-- instead of "Foster". Applicant argues Lancelot does not teach or suggest a concrete section assembly wherein the at least two sections are connected to one another with the deck of each section being substantially co-planar and the second side of the deck of a first section being connected to the first side of the deck of a second section adjoining the first section, the distance, in a direction substantially parallel to the deck of each section, from the center of the first leg to the second leg of the first section is greater than the distance from the center of the second leg of the first section to the center of the first leg of the second section adjoining the first section. Examiner does not agree with the applicant's argument because as set forth in the Office action Lancelot discloses the invention as claimed except from the center of the first leg to the second leg of the first section is greater than the distance from the center of the second leg of the first section to the center of the first leg of the second section adjoining the first section. This feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time invention was made to have such from the center of the first leg to the second leg of the first section is greater than the distance from the center of the second leg of

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the first section to the center of the first leg of the second section adjoining the first section for desirable application. Furthermore, applicant has not disclosed the criticality of this feature.

Examiner believes the prior art teaches the claimed invention as claimed thus the rejections therefore maintain and will made it final.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

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If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

CQN

10/26/2007

*Jeanette E. Chapman*  
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Primary Examiner  
3633